

REMARKS

This is a full and timely response to the final Office Action mailed on August 3, 2005 (Paper No./Mail Date 20050801). Reconsideration and allowance of the Application and presently pending claims are respectfully requested in view of the foregoing remarks.

I. Rejection under 35 U.S.C. 103(a)

Claims 1, 3-5, 7, 8, 18-21, 27, 30, 32, and 37 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,890,319, to *Seth-Smith*. Claims 38-40 and 43-56 stand rejected as allegedly being unpatentable over U.S. Patent No. 4,554,579, to CITTA in view of *Seth-Smith*.

It is well established at law that, for a proper rejection of a claim under 35 U.S.C. §103 as being obvious based upon a single reference, the reference must disclose, teach, or suggest, either implicitly or explicitly, all elements/features/steps of the claim at issue. *See, e.g., In Re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988), and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981).

A. Claim 1

Claim 1, as amended, recites:

A media services client device, comprising:
a memory for storing subscriber identification information;
and
a processor configured to receive the subscriber identification information and a media presentation, wherein the processor is further configured to insert the subscriber identification information into the media presentation, ***wherein the processor is configured to insert textual information of the subscriber identification information during a vertical blanking interval of the presentation of the media presentation, wherein the processor is further configured to ensure that the textual information of the subscriber identification information is completely undetectable to a viewer of the media presentation throughout an entire presentation of the media presentation.***

(Emphasis Added)

- i. *Seth-Smith* fails to disclose, teach, or suggest the feature of “the processor is further configured to ensure that the textual information of the subscriber identification information is completely undetectable to a viewer of the media presentation throughout an entire presentation of the media presentation,” as recited in claim 1.

The Office Action cited on col. 4, lines 50-63 of *Seth-Smith* that “the addition of the user identification is generally imperceptible to the user, but will show up on any copies of the film that are being made.” In fact, *Seth-Smith* further elaborated on col. 25, lines 5-10 that “the copyright proprietor, having located an illegal copy of his copyrighted work made during its transmission over the system of the invention, can readily detect the user's identification number and thus track down the maker of the offensive copy. At the same time, the insertion of the user identification on the screen for but a single frame is barely detectable to the subscriber's eye, such that no significant impairment in picture quality results from implementation of this expedient.” (Emphasis Added, col. 24, line 69 – col. 25, line 9).

Apparently, *Seth-Smith* discloses the viewer being capable of detecting the user identification to track the maker of the offensive copy but such that it's not a distraction to the presentation of the presentation. A disadvantage is that if the maker can detect the user identification, the maker of the offensive copy can remove the user identification from the frame. Whereas, the claimed feature recites that the viewer cannot detect the subscriber identification information. An advantage, among others, to the claimed feature is that because the maker of the offensive copy cannot see the user identification, the maker may believe that the presentation is not being tracked and thus, reduce the possibility of the maker removing the subscriber identification information. In addition, the maker of the offensive copy has a more complicated task of decoding the textual information of the subscriber identification information and then removing it without impairing the picture quality, compared to simply removing the *Seth-Smith* frame that displays the user identification. Applicant respectfully submits that *Seth-Smith* fails to disclose, teach, or suggest the feature of “the processor is further configured to ensure that the textual information of the subscriber identification information is completely undetectable to a viewer of the media presentation throughout an entire presentation of the media presentation,” as recited in claim 1.

- ii. *Seth-Smith* fails to disclose, teach, or suggest the feature of “[inserting] textual information of the subscriber identification information during a vertical blanking interval of the presentation of the media presentation,” as recited in claim 1.

The Office Action alleges that “*Seth-Smith* teaches the template/flag is stored in the vertical blanking interval of the media presentation (col. 7, lines 22-30; col. 8, lines 52-63; col. 10, lines 33-46). However, *Seth-Smith* does not explicitly mention that the insertion is performed during the vertical blanking interval. It is obvious to one skilled in the art that since the template/flag is completed by inserting the data, that the insertion is performed during the vertical blanking interval of the presentation.” (Page 3 of the Office Action). In fact, *Seth-Smith* discloses on col. 24, line 62 – col. 25, line 5 as follows:

“[It] is readily possible to set a ‘fingerprint’ flag bit in the system data portion of the signal, which, when detected by the microprocessor, will cause it to write the subscriber identification number to the screen via the teletext processing facility. (Col. 24, lines 62-67). Typically, this will be done at a particular point in a particular program. Thereafter, the copyright proprietor, having located an illegal copy of the copyrighted work made during the transmission over the system of the invention, can readily detect the user’s identification number and thus track down the maker of the offensive copy.”

Apparently, *Seth-Smith* teaches of a fingerprint flag bit that causes the microprocessor to display the subscriber identification number to the screen, not inserting textual information of the subscriber identification information during the vertical blanking of the presentation of the media presentation, as recited in claim 1. Applicant respectfully submits that *Seth-Smith* fails to disclose, teach, or suggest the feature of “[inserting] textual information of the subscriber identification information during a vertical blanking interval of the presentation of the media presentation,” as recited in claim 1.

iii. Seth-Smith fails to establish a *prima facie* case of obviousness

Because *Seth-Smith* fails to disclose, teach, or suggest the above-quoted features of claim 1, a *prima facie* case of obviousness is not established based on *Seth-Smith*. Consequently, for at least this reason, among others, Applicant respectfully requests that claim 1 be allowed and the rejection be withdrawn.

B. Claims 19, 38, and 50

Claim 19, as amended, recites:

A method for inserting subscriber identification information into media presentations, the method comprising steps of:

receiving subscriber identification information;
storing the subscriber identification information in memory;
receiving a subscriber request for a media presentation; and
inserting the subscriber identification information into the media presentation requested by a subscriber, wherein the inserting of the subscriber identification information occurs at a media services client device, *wherein the media services client device inserts textual information of the subscriber identification information into the media presentation during a vertical blanking interval of a presentation of the media presentation;*
and

configuring the textual information of the subscriber identification information to be completely undetectable to a viewer of the media presentation throughout an entire presentation of the media presentation.

(Emphasis Added)

Claim 38, as amended, recites:

A media services server device comprising:
a memory for storing subscriber identification information;
and

a processor configured to insert the subscriber identification information into a media presentation and transmit the subscriber identification information and media presentation via a network, *wherein the textual information of the subscriber identification information is inserted during a vertical blanking interval of the presentation of the media presentation, wherein the processor is*

further configured to ensure that the textual information of the subscriber identification is completely undetectable to a viewer throughout an entire presentation of the media presentation.

(Emphasis Added)

Claim 50, as amended, recites:

A method for inserting subscriber identification information into media presentations, the method comprising steps of:

storing the subscriber identification information in memory at a media services server device;

inserting the subscriber identification information into the media presentation requested by a subscriber, wherein the inserting of the subscriber identification information occurs at the media services server device;

transmitting the subscriber identification information from the media services server device via a network; and

inserting textual information of the subscriber identification information during the vertical blanking of the presentation of the media presentation; and

configuring the textual information of the subscriber identification information to be completely undetectable to a viewer of the media presentation throughout an entire presentation of the media presentation.

(Emphasis Added)

Applicant respectfully submits that the cited art fails to disclose, teach, or suggest the above-emphasized features of claims 19, 38, and 50. Thus, a *prima facie* case of obviousness is not established based on prior art of record. Consequently, for at least this reason, among others, Applicant respectfully requests that claims 19, 38, and 50 be allowed and the rejection be withdrawn.

II. Miscellaneous

Applicant respectfully traverses all Official Notices and well-known allegations made in the Office Action and submit such should not be considered well-known because the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support the conclusions. The Office Action has taken Official Notice that “it is well known in the art that subscriber information is transmitted via out-of-band pathways or in-band

pathways.” (Page 8 of the Office Action). Applicant traverses this finding for the reason that, in the context of a processor being configured to deliver the subscriber identification information in an out-of-band pathway to the media services client device, subscriber information being transmitted via out-of-band pathways or in-band pathways should not be considered well-known because of the complexity of the technology in the presently claimed combination.

The Office Action further stated that “a MPEG transport stream having a program map is well-known multimedia transport stream to one of ordinary skill in the art.” (Page 9 of the Office Action). Applicant traverses this finding for the reason that, in the context of a data packet of the MPEG transport stream including a program map table that facilitates a media services client device to locate the subscriber identification information, an MPEG transport stream having a program map should not be considered well-known because of the specificity of this finding within the claimed combination.

In addition, according to MPEP 2144.03, “It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.” MPEP 2144.03 also states that “If such notice is taken, the basis for such reasoning must be set forth explicitly. The Office Action must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge.” Accordingly, Applicant respectfully traverses the above conclusions and submit that the subject matter noted above should not be considered well known because the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support the conclusions. Accordingly, Applicant submits that it has not been shown that the material asserted to be well-known is capable of instant and unquestionable demonstration as being well-known.

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known for at least the specific and particular reason that the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions.

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all rejections have been traversed and that the now pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephone conference would expedite the examination of this matter, the Examiner is invited to contact the undersigned agent at (770) 933-9500.

Respectfully submitted,



Jeffrey R. Kuester, Reg. No. 34,367

THOMAS, KAYDEN,
HORSTEMEYER & RISLEY, L.L.P.
Suite 1750
100 Galleria Parkway N.W.
Atlanta, Georgia 30339
(770)933-9500